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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,271	07/24/2003	Takao Yamaguchi	MDA-2880US1	9568
52473	7590	10/27/2006	EXAMINER	
			KOSTAK, VICTOR R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/626,271	YAMAGUCHI ET AL.	
	Examiner	Art Unit	
	Victor R. Kostak	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 102, 103 and 105-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 102, 103, 105 and 107-121 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

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1. Claim 120 is objected to because of the following informalities: the last line should recite “*said starting time information*” rather than the processing term information feature. Appropriate correction is required.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 111-113 stand rejected and new claims 114-116 and 118-121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 111, 114-116 and 118-121, applicant recites the feature of a receiver (or controller) that “*automatically activates* a (said) program” (or data) based on certain transmitted data. However the original disclosure nowhere specifies that a program (or data) is activated *automatically* based on transmitted data. The receiver stage may download certain programming or data in response to initial setting up or user prompting, according to the original disclosure, but nowhere is it described that the receiver “automatically” activates the programming. And as noted in the last Office action, the term “automatically” is nowhere found in the disclosure.

Extending this to dependent claims 104, 106, 110 and 113 where the phrase is repeated, these claims also recite that the automatic activation requires no manual data entry to the

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receiver. The receiver must first be turned on (typically by user prompting) in order to be operational thereafter. Applicant's original disclosure does not address this procedure.

Applicant argues that automatic activation is supported by paragraphs [0246] and [0286] in the corresponding publication. However, a careful reading and interpretation of those two paragraphs (and noting that only those two paragraphs of a specification containing 465 paragraphs were alluded to), the language does not provide definite support, either by implication or deduction, that automatic activation is present.

One of ordinary skill in the art cannot suppose (let alone assume or conclude) the *possibility* of automatic activation of the program or data. Paragraph [0246] at best describes the possibility of realizing broadcasting without [a] return channel. The additional language saying that reproduction of the information or data for broadcasting is started even if information is insufficient does not lead one of ordinary skill in the art to positively conclude that programming is automatically activated. It is emphasized that the enablement requirement does not allow for speculation.

The language covered by paragraph [0286] describing specific transmission signal components also does not lead one of ordinary skill in the art to definitely conclude that the received information is automatically activated. The text therein only requires that execution is started after a certain time period or after a number of setup requests. Based on this paragraph, one of ordinary skill in the art can at best and only conclude that execution of the information (the term "activation" is not used) is done after a passage of time. From this, the skilled artisan can reasonably conclude that the user is prompted (or otherwise informed) to thereby manually activate the presentation of the information, after the time period (or setup times) has elapsed, at

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the preference per individual user. And paragraph [0246] also does not preclude this possibility. Again, descriptions leading to speculation of plural or different conditions does not meet the enablement requirement in describing a single specific condition.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 105 stands rejected and new claim 117 is rejected under 35 U.S.C. 102(e) as being anticipated by Diehl et al. (of record).

Reviewing the system of Diehl, it includes a transmitting end (noting elements 11-14 in Fig. 1) that transmits format information to a receiving end (station comprising components 15-18). The format information transmitted by Diehl includes program identification data and starting time information is transmitted with the program itself (e.g. col. 1 lines 40-44), which data inform the receiving end of which program and what time the program starts (the processing of the program involving presentation thereof). The receiving arrangement automatically activates the program (i.e. the receiver presumably being initially powered up) for processing based on the auxiliary format information data (col. 1 lines 56-65). The claimed “processing term” is met by the starting time (and/or date) of Diehl. The processing term is related to the

identifier specifically based on the fact that it represents the time the program is presented. In a more general interpretation, the starting time (and/or date) are related to the identifier in that they are both transmitted together. Claim 105 accordingly stands rejected.

The fact that Diehl has the user extract commercial data from a broadcast does not dismiss the fact that the format information transmitted by Diehl includes program identification data and starting time information is transmitted with the program itself (noting again col. 1 lines 40-44).

New claim 117 (parallel to claim 105) is rejected on the same grounds.

3. Claims 102, 103, 105 and 107-121 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohga et al.

The video programming communication system of Ohga (noting particularly Figs. 2, 3 and 6) includes a transmitter station 101 (Fig. 2) that transmits format information including an identifier that identifies a program, and starting time information related to the identifier for activating the program at that time (col. 4 lines 16-24). The composite data is to be used by a receiver 102 (Fig. 3). The data is transmitted to the receiver before the starting time for activating (col. 5 lines 2-11), thereby meeting claim 102.

As for claim 103, the starting time information includes a timer (Fig. 6).

As for claims 105, 107 and 117, the starting time information corresponds to the claims processing term.

Regarding claims 108 and 109, Ohga includes a receiving station 102 that receives the transmission format information that is in turn decoded and processed under the control of CPU

25. The identifier and starting time/processing term information is stored in memory 26 (col. 4 line 64 – col. 5 line 1), which data is monitored for eventually activating the program without the need of user intervention.

As for claim 110, controller (CPU) 25 automatically activates the program free of manually entered information (col. 5 lines 2-11).

As for claims 111, 112, 115, 119 and 121, Ohga includes a receiving station 102 that receives the transmission format information that is in turn decoded and processed under the control of CPU 25, and the claimed processing term corresponds to the starting time information, as noted above. Controller (CPU) 25 automatically activates the program free of manually entered information by virtue of the stored data working with CPU 25 (col. 5 lines 2-11).

Considering claim 113, controller (CPU) 25 automatically activates the program free of manually entered information (col. 5 lines 2-11), also discussed previously.

As for claims 114 and 116, the transmitting and receiving system constitute a complete communication system.

As for claims 118 and 120, Ohga includes a receiving station 102 that receives the transmission format information that is in turn decoded and processed under the control of CPU 25. The identifier and starting time/processing term information is stored in memory 26 (col. 4 line 64 – col. 5 line 1), which data is monitored for eventually activating the program without the need of user intervention.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is (571) 272-7348. The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any response to this final action should be mailed to:

Box AF
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Or faxed to:

(571) 273-8300

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office whose telephone number is (703) 308-HELP.

Victor R. Kostak
Primary Examiner
Art Unit 2622

VRK

